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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/843,711 04/16/97 BAGAOISAN

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EXAMINER

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KENNEDY, S

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

04/24/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/843,711

Applicant(s)

Bagaoisan et al.

Examiner

Sharon Kennedy

Group Art Unit

3763



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 6-23 is/are allowed.

☒ Claim(s) 1, 3, and 24-30 is/are rejected.

☒ Claim(s) 2, 4, and 5 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action and the MPEP.

Claim Rejections - 35 USC §251, Recapture

2. Claims 24-30 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Applicant has broadened numerous aspects of the claims rejected in the patent without narrowing another separately patentable feature, and presents them here in the reissue application. Note that the same art used to reject originally presented claims in the parent application are used here to reject new claims 24-30.

Claim Rejections - 35 USC § 102

3. Claims 1, 25-28 and 30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hernandez, US 5,269,759. Hernandez shows the elongated tubular proximal shaft section as the holding attachment 20, an elongated distal shaft section as the guide catheter 10, the third inner lumen being the lumen through the balloon catheter 14 which supports the guidewire, and the connecting means are described at column 5, lines 63-65. Applicant may argue that Hernandez does not disclose an “elongated” proximal shaft, however, applicant provides no qualitative or quantitative description of “elongated,” nor is this a term of art. Accordingly, this term can not be accorded sufficient patentable weight to define over the Hernandez holding attachment 20.

Regarding method claim 27, Hernandez shows the identical device which is also used in the vascular system. It would be obvious to remove holding attachment 20, then guide catheter 10 is another catheter were to be inserted over the guide wire, which, according to applicant's disclosure, occurs often.

4. Claim 28 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Groshong, US 4,431,426. As is well established, intended use is non-limiting in the absence of distinguishing structural characteristics. See also MPEP 2112.01.

5. Claims 25, 28 and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Polin, US 3,828,782. Note the comments set forth in 08/250,785, first office action. See threads 34 which connect the proximal and distal ends.

6. Claims 25, 28 and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Alexander, US 4,004,588.

Claim Rejections - 35 USC § 103

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez '759. It would be an obvious engineering design choice to exchange on common connecting means for another, particularly in view that applicant's specification (patent, column 5, lines 40+) indicates that variations in the connecting means are equivalents for the purpose of the invention.

8. Claims 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander, US 4,004,588. Alexander discloses the identical apparatus but does not show the specific disengagement. However, in column 4, lines 25-30, Alexander discloses that an array of differing flexible conduits may be provided. It would be obvious to disengage the Alexander conduit if during a procedure the surgeon discovers that a conduit needed more flexibility, etc., particularly in view that applicant's disclosure states that the need to change conduits occurs often.

Allowable Subject Matter

9. Claims 2, 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 6-23 are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is (703) 305-0154.

April 20, 2001


Sharon Kennedy
Primary Examiner